

Appl. No. 10/034,502
Docket No. 14XZ00124/GEM-0203

REMARKS / ARGUMENTS

Status of Claims

Claims 1-4 and 6-9 are pending in the application and stand rejected. Applicant has canceled Claims 3 and 4, and has amended Claims 1 and 6, leaving Claims 1-2 and 6-9 for consideration upon entry of the present Amendment.

Applicant thanks the Examiner for reconsidering and withdrawing the objections to the specification and claims, and for reconsidering and withdrawing the rejections under 35 U.S.C. §112, first paragraph.

Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

These amendments and accompanying remarks were not presented earlier because Applicant did not fully appreciate the nature of the Examiner's position until the Applicant was advised in more detail of the position by the final rejection. The claim amendments presented herein, which Applicant respectfully requests entry thereof, should require only a cursory review by the Examiner and should not require further consideration or search.

Rejections Under 35 U.S.C. §103(a)

Claims 1, 3, 6, 8 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Siczek et al. (U.S. Patent No. 5,526,394, hereinafter Siczek) in view of Osaki et al. (U.S. Patent No. 5,163,099, hereinafter Osaki) and further in view of Press et al. (NPL document, see PTO-892, hereinafter Press).

Regarding independent Claims 1 and 6, the Examiner acknowledges that Siczek does not expressly disclose the determining of N autocorrelations of the vector of luminous intensity values, performing the Fourier transform on the autocorrelation vector to obtain the energy frequency spectrum and comparing the energy value at the graduated

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marks with a threshold value, and looks to Osaki and Press to cure these deficiencies. Paper No. 04252005, pages 4-6.

Claims 2, 4 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Siczek in view of Osaki and further in view of Press as applied to Claim 1 above, and further in view of Baxes (NPL document, see PTO-892, hereinafter Baxes).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Regarding Independent Claim 1

Applicant has canceled Claim 3 and has amended Claim 1 to include all the limitations of Claim 3 and more, such that Claim 1 now recites, inter alia,

"A method of automatic detection of a graduated compression paddle used for breast analysis in digital mammography, the method comprising...

...

detecting the paddle; and

unambiguously distinguishing a densest area of the breast from an area of the paddle containing the graduated marks, thereby enabling automatic exposure adjustment based on a most glandular area of the breast;

wherein the acquisition of the image is carried out in an automatic mode, in which an adjustment of the exposure parameters is determined from a table of automatic optimization of parameters (AOP)."

No new matter has been added as antecedent support may be found in the specification as originally filed, such as at Paragraphs [0005], [0020] and [0031] for example. Dependent claims inherit all of the limitations of the parent claim.

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Regarding the limitations of Claim 3, which are now included in Claim 1, the Examiner alleges that Siczek teaches the elements of the claimed invention. Paper No. 04252005, page 6. The Examiner has not applied Osaki, Press and Baxes in alleging obviousness of Claim 3. Applicant agrees with this position, and also submits that Osaki, Press and Baxes do not cure the deficiencies of Siczek in view of the instant amendment.

In addition to the limitation of Claim 3, Applicant also includes the limitation of unambiguously distinguishing a densest area of the breast from an area of the paddle containing the graduated marks, thereby enabling automatic exposure adjustment based on a most glandular area of the breast, submits that Siczek is absent any disclosure, teaching or suggestion of this limitation, and further submits that Osaki, Press and Baxes fail to cure this deficiency.

In Paper No. 04252005, page 3, the Examiner remarks that compression paddles are inherently graduated. However, Applicant submits that the claimed invention is not directed merely to graduated compression paddles, but to a method and apparatus for detecting the graduated marks so as to unambiguously distinguish a densest area of the breast from an area of the paddle containing the graduated marks, thereby enabling automatic exposure adjustment based on a most glandular area of the breast, which is not disclosed, taught or suggested by the cited prior art.

This amendment should require only a cursory review by the Examiner as the Examiner has already considered that the claims are interpreted in light of the specification (Paper No. 04252005, page 4), and as such should not require further consideration or search.

Regarding Independent Claim 6

Applicant has amended Claim 6 to now recite, inter alia,

"A device for automatic detection of a graduated compression paddle used for breast analysis in digital mammography, the device comprising...

...

means for detection capable of deducing the presence of the paddle from the result of the comparison, and unambiguously distinguishing a densest area of the breast from an

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